

### **Remarks**

The present Amendment is made in response to the October 31, 2007, and identified as Paper No. 20071029. Claims 1 and 4-17 are pending.

In the Action, the Examiner rejected claim 6 under 35 U.S.C. § 112, ¶ 2 for the use of the term “said chamber.” The Examiner also rejected claim 1 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,783,117 to Wohrle (“*Wohrle*”), claim 7 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,843,267 to Anderson (“*Anderson*”). Claims 1-2 and 4-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Anderson* in view of U.S. Patent No. 4,260,489 to Greig (“*Grieg*”) and U.S. Patent No. 3,438,502 to Schmidt (“*Schmidt*”). Claims 8-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Anderson*- as applied to claim 7, and further in view of *Greig* and *Schmidt, Jr.*

#### **I. Rejection of the Drawings**

Air purge line 72 connected to the outlet pipe may be seen in several of the drawings, including Figs. 3 and 5-6. See Paragraph [0028]. Claim 8 has been amended accordingly.

#### **II. Rejection of Claim 6 under 35 U.S.C. § 112, ¶ 2**

Claim 6 has been amended to depend from claim 1, which recites “a chamber,” and thus provides an antecedent basis for “said chamber” as recited in line 1 of claim 6.

#### **III. Rejection of claim 1 under 35 U.S.C. § 102**

Claim 1 has been amended to incorporate the limitation from claim 2. Accordingly, no new matter has been added to the claims. As conceded by the Examiner, the limitation of claim 2 is not taught by *Wohrle*. As with Applicant’s prior amendment that simply moved an element from claim 3 into claim 1 and should not have resulted in a final action, the movement of a claim

limitation from a dependent claim into an independent claim does not necessitate a new ground of rejection.

#### **IV. Rejection of claim 7 under 35 U.S.C. § 102(b)**

A rejection under 35 U.S.C. § 102 requires that the reference include each and every limitation recited in the claims. MPEP § 2131 (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”). All of the elements of claim 7 are not disclosed by *Anderson*; thus the claim is not anticipated.

Claim 7 calls for a filter vessel having a rack that may be slid into and out of a compartment. More importantly, claim 7 calls for the rack to have a male connector that engages a corresponding female connector in the compartment, and the female connector must be further connected to an outlet pipe for clean oil discharge. Thus, the rack is fluidly engaged to the outlet pipe of the compartment when the rack is inserted into the compartment due to the cooperation between the corresponding male and female connectors.

The structure identified by the Examiner in *Anderson* does not correspond to any of the express language of claim 7. For example, the Examiner points to a “cover 17” on the sliding rack as having a female connector. Claim 1 specifically recites that the female connector is *in the compartment*, not on a cover or the rack. In fact, *Anderson* does not disclose any connection between the rack and compartment, and thus lacks the claimed rack that is removably positioned in said compartment *such that said male connector engages said female connector when said rack is positioned within said compartment*. This claimed structure is completely absent from *Anderson*. In addition, the Examiner pointed to outlet pipe 63 in *Anderson* as comprising the

claimed outlet pipe, but outlet pipe 63 is not *connected to the female connector of the compartment* as specifically required by the claims. Thus, *Anderson* fails to disclose at least two express claim limitations and cannot anticipate the claimed invention under 35 U.S.C. § 102 as a matter of law.

#### V. Rejections under 35 U.S.C. § 103

All of the rejections under 35 U.S.C. § 103 depend on the Examiner's incorrect analysis of *Anderson*. Even if the proposed combinations are proper, the combination with *Anderson* lacks at least two express claim elements, as explained above. Thus, the Examiner has failed to state a *prima facie* case of obviousness under 35 U.S.C. § 103.

In response to Applicant's prior reply, the Examiner responded that *KSR* forecloses the argument that a specific teaching, suggestion, or motivation is required to support an obviousness rejection. While the Examiner's statement of law is correct, this is not what Applicant argued. See August 13, 2007 Reply at 6-7 ("Although the motivation *does not have to be express* and may be found anywhere in the prior art, including the knowledge of one of skill, the Examiner *failed to identify any such motivation* in the prior art and simply proposed the combination of references without explaining why one of skill would make the proposed combination"). Applicant pointed out that the Examiner failed to articulate *any* reason why one of ordinary skill in the art would make the proposed combination. *KSR* requires *some* teaching, motivation, or rationale for making a combination, which can be an express motivation or one implied from the knowledge of one skilled in the art. The Examiner *never provided any rationale for the proposed combination* and thus failed to state a *prima facie* case under *KSR*.

Applicant also explained why the reference relied on by the Examiner could not be combined. In particular, Applicant explained that *Anderson* teaches upwardly positioned filter elements, while *Schmidt* teaches a downward configuration. The Examiner failed to explain how these completely opposite systems could be combined to create a working system. Indeed, *Anderson* would not work if modified according to *Schmidt* as it requires a completely opposite configuration. Accordingly, the proposed modification would violate the rule that the proposed modification cannot render the prior art unsatisfactory for its intended purpose. See MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). The Examiner failed to address this reason why the proposed combination is improper.

Authorization for a Petition for a Two-Month Extension has been submitted herewith.

In view of the foregoing amendments as supported by these remarks, the Examiner's reconsideration and allowance of the present application is respectfully requested. If the Examiner believes that a telephone conference will expedite handling of the present application, please contact the undersigned at (315)218-8515.

Respectfully submitted,

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